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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,769	03/29/2001	Seiji Yamashita	1581/00260	2632

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/819,769

Applicant(s)

YAMASHITA ET AL.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 9-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-27 are pending. Note that, the preliminary amendments filed 8/31/01 and 1/16/03 have been entered.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 9/29/98. However, a certified copy of JP 10/274,563 has not been placed in the file. Note that, the Examiner has requested a copy of the priority document from the PTO-PCT branch and priority will be granted upon receipt of the document. Currently, priority has not been granted.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8 and 22-27, drawn to a nonionic surfactant comprising an aliphatic alcohol alkylene oxide adduct.

Group II, claim(s) 9-14, drawn to a process for producing an aliphatic alcohol alkylene oxide adduct.

Group III, claim(s) 15-21, drawn to an anionic surfactant.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, at least, is anticipated by or obvious over EP 228,121. Consequently, the special technical feature which links claims 1-14 and 22-27, a nonionic surfactant comprising an aliphatic alcohol alkylene oxide adduct, does not provide a contribution over the prior art, so unity of

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invention is lacking. Claims 15-21 lack this feature entirely, so there is no unity of invention between those claims and claims 1-14 and 22-27.

During a telephone conversation with Burton Amernick on May 15, 2003, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and 22-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 228,121, EP 043,963, Edwards (US 4,396,779), or Tartakovsky et al (US 5,981,456).

'121 teaches a process for the preparation of an alkanol alkoxylate product having a narrow-range alkylene oxide adduct distribution and a low content of residual alkanol, which comprises reacting an alkylene oxide reactant comprising one or more C2 to C4 vicinal alkylene oxides with an alkanol reactant comprising one or more C6 to C30 alkanols in the presence of a catalytically effective amount of a catalyst prepared by contacting (i) one or more sulphur-containing acids and (ii) one or more aluminum compounds selected from the group consisting of aluminum alcoholates and aluminium phenolates. See Abstract. Examples of such commercially available alkanol mixtures include the Neodol alcohols including C9, C10, C11 alkanols, mixtures of C12 and C14 alkanols (Alfol 1214), etc. See page 4, lines 1-15.

'963 teaches a process for the preparation of stable nonionic surface active agents by converting primary monohydric alcohols which contain a range of chain lengths having 10 to 20 or more carbon atoms which comprises reacting ethylene oxide with primary monohydric alcohols up to about 30 percent by weight of which contain

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from about 16 to 20 carbon atoms, in the presence of an acid catalyst for the time necessary to obtain an adduct containing 1 to 6 moles of ethylene oxide, neutralizing and washing said reaction mixture and then reacting the same with ethylene oxide in the presence of an alkaline catalyst. The nonionic surface active agents prepared thereby are stable, clear liquids which do not form a precipitate after extended periods of storage or when mixed with other conventional formulating ingredients. See page 4, lines 5-22. Suitable alcohols include n-decanol, n-dodecanol, n-tridecanol, n-tetradecanol, etc. See page 8, line 25 to page 9, line 10.

Edwards teaches a process the preparation of alkanol alkoxylates, useful as nonionic surfactant, comprises steps for alkoxylating one or more alkanols having carbon number in the range from 8 to 18 by reaction with one or more alkylene oxides having carbon number in the range 2 to 4 under alkaline pH and in the presence of one or more soluble compounds of calcium, and neutralizing the resulting alkoxylation mixture by addition thereto of an acid selected from the group consisting of propionic acid, benzoic acid, and mixtures thereof. The products are characterized by a single phase of low viscosity. See Abstract. The alkanol reactant that is suitable for use in practice includes one or more of the same C8 and C18 alkanols. See column 3, lines 40-50.

Tartakovsky et al teach an automatic dishwashing detergent composition which contains an effective amount of a defined water soluble cationic or amphoteric polymer and a phosphate or nonphosphate builder. The polymers are soluble or dispersible to at least 0.01% by weight in distilled water at 25 degrees Celsius. A method of using

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polymers to prevent fading or corrosion of dishware is also described. See Abstract. Additionally, a surfactant may be included in the composition and suitable surfactants include anionic, nonionic, etc. Suitable nonionic surfactants include ethoxylated fatty alcohols such as alcohols having from 6 to 20 carbon atoms in the alkyl group and 2 to 8 ethylene oxide groups. Additionally, other suitable nonionic surfactants include polyoxyethylene-polyoxypropylene block copolymers having the same general formula as recited by the instant claims. These materials are known under the trademark Pluronic and Pluronic R. See column 14, lines 1-65.

Note that, with respect to the cleaning properties and other physical parameters as recited by the instant claims, the Examiner asserts that the broad teachings of '121, 963, Edwards, or Tartakovsky et al encompass nonionic surfactants having the same cleaning properties and other physical parameters as recited by the instant claims because '121, 963, Edwards, or Tartakovsky et al teach nonionic surfactants having the same alkanol and alkoxyate groups as recited by the instant claims.

Note that, with respect to the product-by-process limitations as recited by instant claim 1, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Additionally, once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with



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evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

'121, 963, Edwards, or Tartakovsky et al do not specifically teach a nonionic surfactant having the specific cleaning properties and physical parameters as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a nonionic surfactant having the specific cleaning properties and physical parameters as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of '121, 963, Edwards, or Tartakovsky et al suggest a nonionic surfactant having the specific cleaning properties and physical parameters as recited by the instant claims.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703)

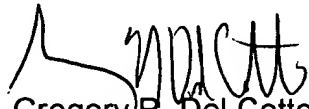
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308-2519. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Gregory R. Del Cotto  
Primary Examiner  
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GRD  
May 18, 2003